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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,615	10/29/2003	Kenneth E. Trueba	10010217-3	9627

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EXAMINER
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MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3734

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/697,615

Applicant(s)

TRUEBA, KENNETH E.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 10-14, 16-25, 27, 30, 32-52 and 54-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-14, 16-25, 27, 30, 32-52 and 54-57 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 2 March have been fully considered but they are not persuasive. The applicant argues that Klimowicz et al. does not teach an inkjet dispenser. The examiner disagrees. As disclosed in the specification of the instant application pg 10, paragraph [36], "In piezoelectric inkjet technology, an activation pulse is applied to a piezoelectric plate or member attached to a plate, which then responds by flexing to propel an ink drop out of a nozzle". The device of Klimowicz et al. works in a similar way (col. 3, lines 20-40). The applicant also discloses how a piezoelectric inkjet works in the incorporated application 10/007,133 (now patent 6684880). In col. 3, lines 24-26, of patent 6684880 the applicant discloses a piezoelectric inkjet as "movement of a piezoelectric transducer changes a chamber volume to generate the drop". In Klimowicz et al., vibration of 36 changes the volume of 30 expelling fluid through 37.
2. As to the argument that Klimowicz et al. does not teach that the dispenser may be electronically programmed. The recitation that an element is "programmable" for performing a function is not positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. The prior art only needs the ability to be programmed. The device of Klimowicz et al. comprises a control system that is programmable to work in different modes (col. 4, line 10 thru col. 5, line 3). Klimowicz et al. also teaches dispensing different ratios (col. 4, line 64 thru col. 4, line 3).

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3. Applicant's arguments, see pg 14, lines 6-12, filed 2 March 2006, with respect to claims 1, 19, 33, and 43 have been fully considered and are persuasive. The 103(a) of claims 1-7, 10, 16, 19-25, 27, 30, 32-36, and 43-48 have been withdrawn.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 54-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 54 and 55 provides for the use of a controller, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

7. Claims 56 and 57 provides for the use of droplet, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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9. Claims 54-57 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

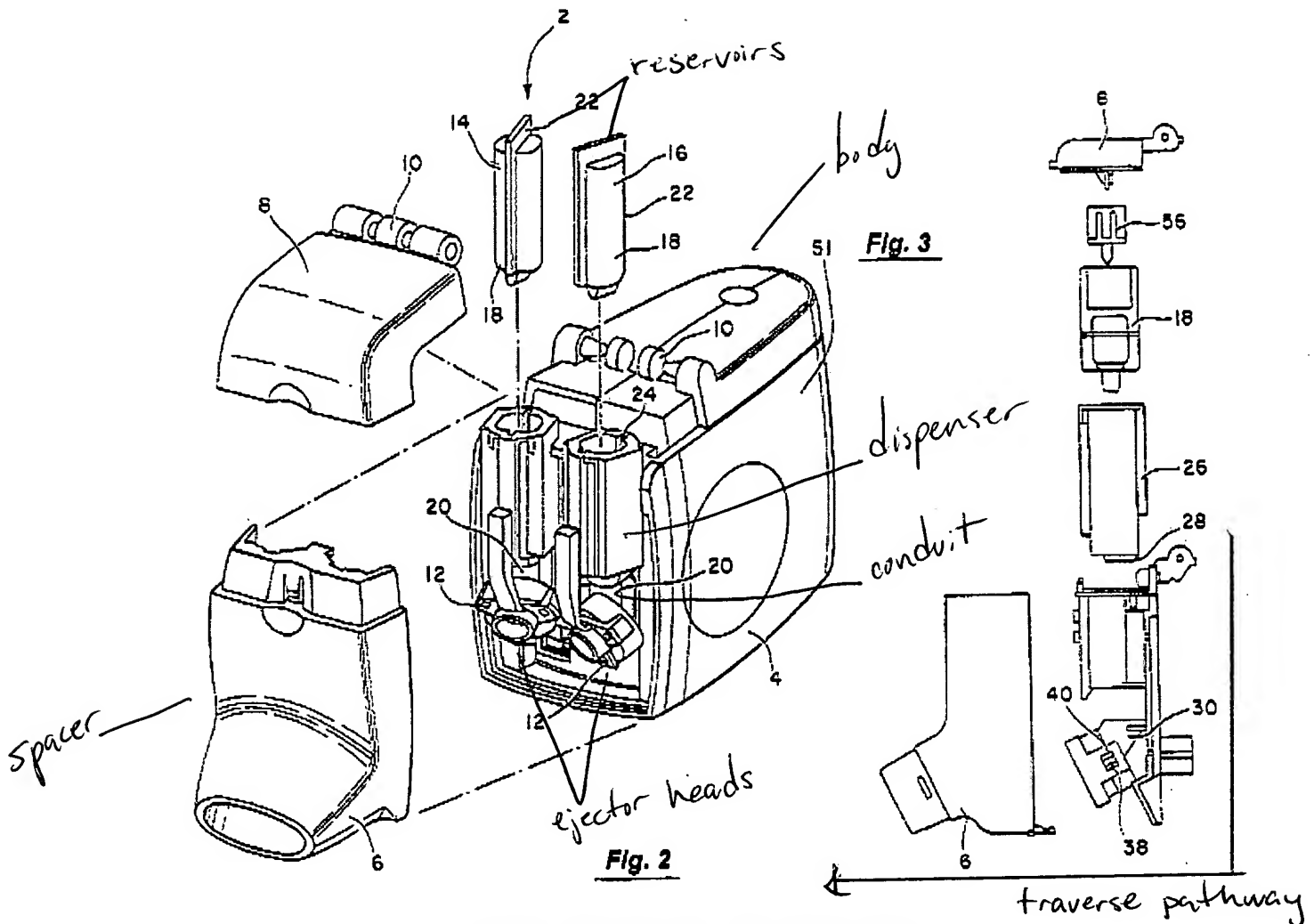
11. Claims 1-7, 10-13, 16, 17, 33, 34, 36, 43-46, 48-52, 56, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Klimowicz et al. 6543443.

12. Klimowicz et al. teaches an applicator for delivering two or more different bioactive compositions comprising: an inkjet dispenser comprising an multiple ejector heads, each of which is in fluid communication with an orifice 37, the inkjet dispenser further including a main body; multiple replaceable fluid reservoirs 14 and 16, each of which is configured to hold and to simultaneously deliver one of the bioactive compositions (col. 2, line 50-52) to respective one of the multiple ejector heads; the replaceable fluid reservoirs at least partially insertable through the body, and each of the multiple reservoirs configured to hold a different bioactive composition; a body

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spacer 6; an electronic programmable device; wherein the applicator is an inhaler; wherein the applicator is a pulmonary inhaler; wherein the inkjet dispenser is a piezoelectric droplet inkjet dispenser 48; wherein the spacer is external to the body; wherein the inkjet dispenser is adapted to dispense droplets of the bioactive composition sized for respiratory inhalation; wherein the inkjet dispenser is adapted to dispense droplets of the bioactive composition sized for delivery to bronchial airways; wherein the spacer is a mouthpiece spacer or a nasal spacer and the inkjet dispenser is disposed within the spacer; further comprising a fluid conduit extending between each of the fluid reservoirs and the inkjet dispenser, the fluid conduits adapted to deliver the bioactive compositions from the fluid reservoirs to the inkjet dispenser, the fluid conduits extending at least partially through the spacer; a programmable controller 51 adapted to control the inkjet dispenser; wherein the controller is programmed to deliver bioactive compositions from the applicator in response to clinical or physical information (col. 4, line 10 thru col. 5, line 20).

13. As to claim 17, the recitation that an element is "programmable" for performing a function is not positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense



**Claim Rejections - 35 USC § 103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 19, 20, 22-25, 27, 30, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimowicz et al.

16. Klimowicz et al. discloses the claimed invention except for a third ejection head. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a third ejection head, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.
17. Claims 14, 21, 35, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimowicz et al. in view of Voges 5894841.
18. Klimowicz et al. teaches the applicator as in the above 102(b) rejection. It should be noted that Klimowicz et al. fails to teach wherein the inkjet dispenser is a thermal droplet inkjet dispenser. Klimowicz et al. teaches a piezoelectric dispenser. However, Voges teaches that thermal inkjet dispenser as an alternative to using a piezoelectric dispenser. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a thermal inkjet dispenser as an alternative to a piezoelectric inkjet dispenser.
19. Claims 18 and 37-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimowicz et al. in view of Scheuch et al. US 2001/0037806 A1.
20. Klimowicz et al. teaches the applicator as in the above 102(b) rejection. It should be noted that Klimowicz et al. fails to teach an input slot for removable memory electrically connected to the processor.
21. Scheuch et al. teaches an applicator the used a common slot (see fig. 2) for inserting memory. Therefore it would have been obvious to one having ordinary skill in



the art to include the slot of Scheuch et al. in the applicator of Klimowicz et al. to allow for remote reprogramming of the applicator by a physician (paragraphs [0014]-[0018].

22. As to claims 18 and 39-41, Klimowicz/Scheuch teaches wherein the means for programming is a keypad or a touch screen mounted on a body of the inkjet dispenser; a display screen electrically connected to the processor (see fig. 2); and wherein the input slot is an input slot for a flash memory card (paragraph [0014]).

23. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klimowicz/Scheuch in view of Voges 5894841.

24. Klimowicz/Scheuch teaches the applicator as in the above 102(b) rejection. It should be noted that Klimowicz/Scheuch fails to teach wherein the inkjet dispenser is a thermal droplet inkjet dispenser. Klimowicz/Scheuch teaches a piezoelectric dispenser. However, Voges teaches that thermal inkjet dispenser as an alternative to using a piezoelectric dispenser. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a thermal inkjet dispenser as an alternative to a piezoelectric inkjet dispenser

### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MM

A handwritten signature in black ink, appearing to read "M J Hayes", written in a cursive style.

**MICHAEL J. HAYES  
PRIMARY EXAMINER**